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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,093	01/28/2004	Steven M. Bessette	WFG-4380-150	9833

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EXAMINER	
QAZI, SABIHA NAIM	
ART UNIT	**PAPER NUMBER**
1616	
MAIL DATE	**DELIVERY MODE**
06/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/765,093	BESSETTE, STEVEN M.	
	Examiner	Art Unit	
	Sabiha Qazi	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 July 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 3-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *1, 3-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Final Office Action

Claims 1, 3-14 is pending. No claim is allowed at this time. Amendments are entered.

Summary of this Office Action dated Tuesday, September 12, 2006

1. Response to Remarks
2. Information Disclosure Statement
3. Copending Applications
4. Specification
5. Double Patenting Rejection
6. 35 USC § 103(a) Rejection
7. Communication

Response to Remarks

- Applicant's arguments were fully considered but are not found persuasive therefore all the rejections are maintained for the same reasons as set forth in our previous office action.
- Applicant argue that clove oil contains more ingredients Examiner agrees however Examiner do not agree that clove oil is not taught. Furthermore, Applicants have not shown any criticality and/or unexpected results for their invention compared to prior art teaching. The invention as claimed is considered obvious over the prior art.
- Double rejection is maintained and would be withdrawn when Applicants will file a terminal disclaimer.
- Applicant is requested to show the support of amendments in the disclosure. No example in the disclosure contains only clove oil and thyme oil. There are other ingredients.

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Copending Applications

Applicants must bring to the attention of the examiner, or other Office official involved with the examination of a particular application, information within their knowledge as to other copending United States applications, which are "material to patentability" of the application in question. MPEP 2001.06(b). See Dayco Products Inc. v. Total Containment Inc., 66 USPQ2d 1801 (CA FC 2003).

Specification

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 8, 9, 10, and 14 are rejected under the judicially created doctrine of double patenting over claims 1-9 of BESSETTE (US Patent No. 6,506,707) since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: The claims are drawn to a method for controlling/killing weeds and grasses by applying a composition comprising thymol and eugenol (clove oil). Instant claims differ from the claims of the reference in not claiming synergistic compositions used in the methods.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application, which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 and 3-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over YU et al.[1] (US Patent 5,811,079), TWORKOSKI (Journal reference: "Herbicide Effects of Essential Oils," *Weed Science*, 50(4): 425-431, 2002) and FAUST, ROBERT H.[2] These reference teach a composition and method which embraces Applicant's claimed invention. See the entire documents.

YU teaches a composition containing aromatic oils including methyl salicylate, eugenol, iso-eugenol, clove oil, thymol, see lines 12-56 in column 4, lines 4-14 in column 5.

FAUST teaches the use of humic acid and fulvic acid. Fulvic acid increases the absorption. See the entire document, especially table on page 2

TWORKOSKI teaches that clove oil, when applied to a plant, causes severe electrolyte damage and cell death. Furthermore it teaches the composition containing rhyme and clove (Table 1 on page 426) and figure 1 on page 427, figure 2 and 3 on page 428 where various concentrations of essential oils are disclosed including clove and red thyme and figure 4 and figure 5 on pages 429-430.

It would have been obvious to one skilled in the art at the time of invention to prepare a composition comprising and clove oil, thymol, methyl salicylate, eugenol because YU teaches compositions containing aromatic oils and TWORKOSKI teaches the use of clove oil as an herbicide. This embraces the presently claimed invention; therefore, the instant invention is considered *prima facie* obvious over the prior art. Methyl salicylate is a flavoring agent (found in oil of Wintergreen). Examiner notes, that

[1] YU et al. (US Patent 5,811,079)

no example in the disclosure contains only clove oil and thyme oil as cited in amended claims. There are other ingredients.

Even in a case where the reference does not teach the same use of the composition, the two different intended uses are not distinguishable in terms of the composition, see *In re Thuau,* 57 USPQ 324; *Ex parte Douros,* 163 USPQ 667; and *In re Craige,* 89 USPQ 393.

A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill might reasonably infer from the teachings. *In re opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA 1976). A reference is not limited to working examples. *In re Fracalossi* 215 USPQ 569 (CCPA 1982).

Accordingly, the burden of proof is upon applicants to show that instantly claimed subject matter is different and unobvious over those taught by prior art. See *In re Brown*, 173 USPQ 685, 688; *In re Best*, 195 USPQ 430 and *In re Marosi*, 218 USPQ 289, 293.

In the light of the forgoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the instant claims would have been obvious within the meaning of 35 U.S.C. 103(a).

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[2] FAUST (http://www.bioag.com/fulvi-seedtreat.html)

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha Qazi, Ph.D. whose telephone number is 571-272-0622. The examiner can normally be reached on any business day.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Johann Richter, Ph.D. can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S. Qazi

SABIHA QAZI, PH.D
PRIMARY EXAMINER